

REMARKS

Applicants respectfully request reconsideration of the application in view of the following remarks.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Banas et al (USPN 5,749,880) in view of Frantzen (USPN 6,042,606)

Claims 114-117, 121-129 and 133-137 have been rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Banas in view of Frantzen.

Applicants respectfully submit that Banas in combination with Frantzen does not render the pending claims obvious to one of ordinary skill in the art. The U.S. Court of Appeals for the Federal Circuit has held that “[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness...It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

The Examiner merely states that “it would have been obvious to one of ordinary skill in the art to use zigzag elements with a linear connector as taught by Frantzen in the graft of Banas et al. such that it provides a non-foreshortening stent for maximum vessel coverage.” Office Action at p. 3.

Thus, the Examiner does not point to any discernible suggestion in either Banas or Frantzen that would lead one of ordinary skill in the art to combine the two references. What the Examiner offers is the unsupported assertion that a skilled artisan would have been motivated to combine the two references.

Such an assertion cannot be used to base a finding of obviousness. In re Fine, 837 F. 2d 1071, 1074 (Fed. Cir. 1988). The In re Fine court held that “the Examiner’s bald assertion” that substitution of an element from one reference into another “would have been within the skill of the art” cannot support a finding of obviousness. Id. In the instant case too, the Examiner’s

statement about combining Banas with Frantzen is an assertion that is not adequate to support a 103 rejection of Applicants' pending claims.

Applicants also respectfully submit that there is no basis which would support the combination.

Frantzen cannot be combined with Banas to reject the pending claims because creating a non-foreshortening stent-graft requires not just a non-foreshortening stent but also a non-foreshortening graft, which is not taught by either reference. In fact a person of ordinary skill in the art would have concluded that a non-foreshortening stent would not work with a graft because such a skilled artisan may have concluded that expansion of the non-foreshortening stent would tear the graft. Thus, combining Banas with Frantzen to yield the claimed invention would not have been obvious to a person of ordinary skill in the art.

Case law unequivocally establishes that the motivation to support a combination of references must withstand scrutiny. The Federal Circuit's discussion of this requirement in In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998) is instructive. There the Court stated:

“[V]irtually all [inventions] are combinations of old elements.” Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 U.S.P.Q. 8, 12 (Fed. Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 U.S.P.Q. 2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

Id. at 1357. The court then noted that the Board had failed to “explain what *specific* understanding or technological principle within the knowledge of one of ordinary skills in the art would have suggested the combination.” *Id.* (emphasis added). Finding that the Board had “merely invoked the high level of skill in the . . . art,” the court stated:

If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, ***the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.***

Id. at 1357-1358 (emphasis added).

Applicants submit that, in the present case, the Examiner has failed to identify the “*specific* understanding or technological principle within the knowledge of one of ordinary skill in the art” that would lead to the *specific* combination on which the rejection is based.¹

¹ See also Ex Parte Clapp, 227 U.S.P.Q. 2.d 1300 (Bd. Pat. App. & Inter. 1985) (When the references do not explicitly suggest combining their teachings, the Examiner must present a convincing line of reasoning to support the rejection.) Thus, a conclusory statement that a reference can be used to improve a certain technique hardly amounts to a reasoned explanation of why it would have been proper to combine that reference with another reference. While the Federal Circuit has held that the recognition of some advantage or expected beneficial result may be a rationale for combining references, that recognition must exist impliedly or explicitly in the references or *be drawn from a convincing line of reasoning based on established scientific*

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Accordingly, the Examiner has failed to provide sufficient support for a case of *prima facie* obviousness.

The Examiner's attempt to combine Banas with Frantzen by simply assuming that these two references can be combined does not comport with the Federal Circuit's well-established rule that the mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F. 2d 680 (Fed. Cir. 1990). See also In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989)

The Federal Circuit has stated that it is impermissible simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. Interconnect Planning Corporation v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985). The references themselves must provide some teaching whereby the applicant's combination would have been obvious. In re Gorman, 933 F.2d 982 (Fed. Cir. 1991). For all of the foregoing reasons, Applicant submits that the attempted combination of references is based on impermissible hindsight reconstruction and the references do not provide any teaching that would have rendered Applicant's invention obvious.

Banas et al (USPN 5,749,880) in view of Lau et al (USPN 6,066,168)

Claims 114-116, 118, 121-128, 130 and 133-137 have been rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Banas in view of Lau. As with the previous rejection discussed above, the Examiner does not point to any suggestion in the references to combine the references, nor does he point to a specific scientific or technical principle that would support the combination. Therefore, for the foregoing reasons, the Examiner's rejection of the pending claims over Banas in view of Lau is also improper.

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principles or legal precedent. In re Sernaker, 702 F. 2d 989, 994 (Fed. Cir. 1983) (emphasis added).

Banas et al (USPN 5,749,880) in view of Frantzen et al (USPN 6,042,606) and further in view of Myers et al (USPN 5,700,285)

Claims 119, 120, and 131-132 have been rejected under 35 U.S.C. § 103 as being allegedly unpatentable over Banas in view of Frantzen as applied to claims 114, 126 and further in view of Myers. As with the previous two rejection discussed above, the Examiner has failed to establish a *prima facie* case of obviousness. Once again the Examiner only offers the bald assertion that “it would have been obvious to one of ordinary skill in the art” to combine Myers’s tape thickness with the combination of Banas and Frantzen to obtain the claimed invention. As shown by the Applicants above, there is no motivation to combine Banas with Frantzen and, therefore, there can be no motivation to combine Banas, Frantzen and Myers. Accordingly, the rejection of claims 119, 120 and 131-132 under 35 U.S.C. § 103 is also improper.

Applicants respectfully submit that, for all of the foregoing reasons, rejection of the pending claims under 35 U.S.C. § 103 is not supported by law and, therefore, should be withdrawn.

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